

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UBER TECHNOLOGIES, INC.,  
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT LLC,  
Patent Owner.

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IPR2021-01306  
Patent 10,341,838 B2

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Before CHARLES J. BOUDREAU, DANIEL J. GALLIGAN, and  
IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing of  
Decision Granting Institution of *Inter Partes* Review  
*37 C.F.R. § 42.71(d)*

## I. INTRODUCTION

Patent Owner AGIS Software Development LLC requests reconsideration of our Institution Decision (Paper 10, “Inst. Dec.”), in which we instituted *inter partes* review of claims 1–26 of U.S. Patent No. 10,341,838 B2 (“the ’838 patent,” Ex. 1001). Paper 12 (“Req. Reh’g”). Patent Owner argues that we “misapprehended the application of *Fintiv*<sup>1</sup> Factors 1, 3, and 6 and overlooked crucial facts weighing in favor of denial” and erred in our analysis of the Petition’s merits. Req. Reh’g 1–2.

For the reasons that follow, Patent Owner’s request for rehearing is *denied*.

## II. ANALYSIS

### A. *Applicable Legal Standard*

The standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). A rehearing request is not an opportunity for the requesting party to reargue its case or merely to express disagreement with the underlying decision. Nor is it an opportunity for the moving party to present new arguments that were not in its original submissions.

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<sup>1</sup> *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

*B. Merits of the Petition*

On rehearing, Patent Owner argues that in preliminarily determining that Makoto discloses “permitting the first mobile device corresponding to the vehicle to join a communication network, the permitting based on a determination regarding the first data,”<sup>2</sup> recited in claim 1 of the ’838 patent, we misapprehended or overlooked “the scope of the claim limitation, the disclosures in the Makoto reference, and the contentions of the Petition.” Req. Reh’g 7–8. Specifically, Patent Owner argues that our “interpretation reads out requirements of the claim limitation, which requires that the server make the determination in permitting the vehicle’s device to join the network and that the determination made at the server must be based on that first data that includes the first identifier.” *Id.* at 7.

We find that Patent Owner has not shown that anything was misapprehended or overlooked in the Institution Decision. Patent Owner chose to not argue for an express construction of “permitting based on a determination regarding the first data,” and instead argued only that Makoto does not disclose this limitation under its plain and ordinary meaning. Paper 6, 10–11. As we explained in the Institution Decision,

The claim merely requires “permitting based on a determination regarding the first data.” There is no requirement of any sort of mediation on the part of the server, as asserted by Patent Owner, and Patent Owner fails to point us to any support in the specification for such a requirement.

Inst. Dec. 25 (citing Paper 6, 11). We found that Makoto’s registration process based on a determination of the mobile devices belonging to the

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<sup>2</sup> Ex. 1001, 15:9–11. Independent claim 14 of the ’838 patent recites a similar limitation. *Id.* at 17:11–14.

group to be registered meets this claim limitation for the purposes of institution. *Id.* at 25–26.

On rehearing, Patent Owner contends that we misapprehended the scope of the claim limitation, but once again fails to point us to any support that requires a narrower construction. *See* Req. Reh’g 7–8. The ’838 patent discloses that the server merely “allows the set up of the ad hoc network” and “acts as a forwarder for IP communications between any combination of cell phone/PDA users and/or PC based user[s].” Ex. 1001, 5:18–34; *see also id.* at 11:1–41. We find no support in the specification to require a *specific* determination to be made by the server in permitting devices to join a network, and Patent Owner has not pointed us to one. Patent Owner’s contention that the claim requires more than registering a group of mobile devices as taught by Makoto (Req. Reh’g 8) is, therefore, unsupported on this record.

Patent Owner’s argument that we did not identify “any evidence that Makoto’s location information service providing device 305 makes any determination to permit the device to join” is also misplaced. Req. Reh’g 8. We explained that “Makoto’s location information service providing device 305 *determines* the mobile devices belonging to the group and *issues* a group ID, which has to be used by the mobile devices to obtain location information for other devices from that server.” Inst. Dec. 25 (citing Pet. 12–13; Ex. 1005 ¶¶ 106, 114, 119; Ex. 1002 ¶¶ 70–71); *see also id.* at 18 (detailing Petitioner’s contention that “Makoto’s location information service providing device 305 *determines* which mobile devices belong to a group”). We were sufficiently persuaded by Petitioner’s contention that “a person of ordinary skill in the art would have therefore recognized that location service providing device 305 permits the mobile device to join a

communication network” based on that determination. *Id.* at 18 (citing Pet. 13–14; Ex. 1005 ¶¶ 106, 114, 117, 119, 124; Ex. 1002 ¶¶ 72–74). We further explained that “even though mobile device 304<sub>1</sub> includes communication devices IDs of a plurality of mobile communication devices in the group registration request to Makoto’s location information service providing device 305, i.e., the server, it is the server that permits the mobile device to join the network.” *Id.* at 26. That is, even though each individual device in Makoto specifies sharing permissions of *its* location information, it is the server that permits the group of devices to join a network based on a determination regarding which mobile devices belong to that group.

Petitioner’s contentions are further supported by Dr. Chatterjee’s testimony regarding Makoto’s registration procedure, explaining that a person of ordinary skill in the art would have understood that Makoto’s location service providing device 305 permits the mobile device to join a network based on a determination of the communication IDs of the devices belonging to the group and contained in the group registration request received from the mobile device. Ex. 1002 ¶¶ 71–74. We gave certain weight to Dr. Chatterjee’s un rebutted testimony and determined that Petitioner had met its threshold burden of demonstrating a reasonable likelihood of prevailing at trial with respect to this claim limitation. Inst. Dec. 25–26. Patent Owner’s disagreement with our analysis or that determination is not a proper basis for rehearing.

For the foregoing reasons, we are not persuaded that we misapprehended or overlooked any matters in reaching our preliminary determination that Makoto discloses “permitting the first mobile device corresponding to the vehicle to join a communication network, the

permitting based on a determination regarding the first data,” as recited in claim 1.<sup>3</sup>

*C. Discretionary Denial under 35 U.S.C. § 314(a) (Fintiv)*

On rehearing, Patent Owner challenges our determinations with respect to *Fintiv* factors 1 (whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted), 3 (investment in the parallel proceeding by the court and the parties), and 6 (other circumstances that impact the Board’s exercise of discretion, including the merits). Req. Reh’g 1–7. The related litigation on which the *Fintiv* arguments are based is *AGIS Software Development LLC v. Uber Technologies, Inc.*, No. 2:21-cv-00026-JRG (E.D. Tex. Jan. 29, 2021), which has been consolidated into *AGIS Software Development LLC v. T-Mobile USA, Inc.*, No. 2:21-cv-00072-JRG (E.D. Tex. March 3, 2021). Inst. Dec. 2, 5–14.

We determined that the first *Fintiv* factor is neutral because the district court had not yet ruled on Petitioner’s motion to stay (Ex. 1025), and we declined to speculate as to how the district court might rule. Inst. Dec. 7. Patent Owner argues that we “misapprehended and overlooked specific evidence that the district court would not stay the case, including past denial and docket control orders confirming that the district court was maintaining the March 7, 2022 trial date.” Req. Reh’g 3 (citing Papers 6, 8–9; Exs. 2002, 2003). Patent Owner further argues that the district court denied

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<sup>3</sup> Patent Owner also incorrectly asserts that we made a “finding of anticipation for this claim limitation.” Req. Reh’g 8. Petitioner’s asserted grounds and our institution decision regarding those grounds is, however, based on obviousness. *See* Inst. Dec. 5.

a motion to stay on January 4, 2022, and that the “repeated denials of Uber’s stay motions must weigh against institution.” *Id.* (citing Exs. 2011, 2012).

We do not agree that we should change our evaluation of the first factor. Exhibit 2011 is an order denying a motion to stay based on a standing issue. That order was in the record as Exhibit 1027 at the time we issued our Institution Decision and does not change our analysis. *See* Paper 7, 1 (Petitioner’s Preliminary Reply citing Exhibits 1026 and 1027). Exhibit 2012 reflects the denial of a motion to stay that is document 117 on the district court docket. That motion was filed under seal on August 10, 2021, and is not in the record, but the redacted public version shows that the motion also pertained to the standing issue. Ex. 3006. On January 7, 2022, Petitioner filed a motion to stay based on this IPR and other proceedings before the Office. Ex. 3005. It does not appear that the district court has issued a ruling on that motion, and we decline to speculate as to how the district court will rule.

We maintain our determination that the first *Fintiv* factor is neutral to the exercise of our discretion.

For the third *Fintiv* factor, we determined that “Petitioner’s diligence in filing the Petition tips this factor against exercising our discretion to deny the Petition.” Inst. Dec. 8–10. Patent Owner faults our determination that Petitioner was diligent. Req. Reh’g 4–7. According to Patent Owner, Petitioner “knew that AGIS asserted all valid claims of the Patents-in-Suit identified in its Complaint.” *Id.* at 5. Based on this assertion, for which no evidence is cited, Patent Owner argues that “Petitioner should have prepared its petitions before the disclosure of asserted claims and filed its petitions when it learned of the asserted claims on May 19, 2021.” *Id.*

We disagree with Patent Owner. As an initial matter, Patent Owner’s district court complaint against Petitioner only specifically identifies claim 1 of the ’838 patent and otherwise generally asserts infringement of “one of more claims.” Ex. 3004 ¶¶ 75–92. Patent Owner’s position would require a petitioner to immediately start drafting a petition for *inter partes* review as to every claim of an asserted patent upon receipt of a complaint even without knowing what claims are asserted. Our precedent counsels otherwise: “[I]t is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.” *Fintiv*, Paper 11 at 11. The unreasonableness of Patent Owner’s position is underscored by the fact that Patent Owner itself sought, and was granted, an extension of time to provide infringement contentions – from April 28, 2021, to May 19, 2021. Exs. 3001, 3002. Thus, Patent Owner needed almost four months from filing its complaint against Petitioner on January 29, 2021, to produce infringement contentions on May 19, 2021, in which it identified the claims it was asserting against Petitioner. Yet, Patent Owner argues that Petitioner should have filed the Petition “when it learned of the asserted claims on May 19, 2021.” Req. Reh’g 5. Under the circumstances here, this is not a reasonable demand.

For the reasons stated in the Institution Decision, we find that Petitioner was diligent in filing the Petition. Inst. Dec. 8–10. We are not persuaded that we misapprehended or overlooked any matters in reaching our determination that the third *Fintiv* factor weighs against exercising our discretion to deny the Petition.

As to the sixth *Fintiv* factor, Patent Owner relies on its arguments for “permitting the first mobile device corresponding to the vehicle to join a communication network, the permitting based on a determination regarding

the first data.” Req. Reh’g 1–2, 7–8. For the reasons discussed in the preceding section, we disagree with Patent Owner’s arguments, and, therefore, we maintain our determination as to this factor. *See* Inst. Dec. 12–13 (finding that the sixth *Fintiv* factor weighs against exercising discretion to deny).

After considering Patent Owner’s arguments on rehearing, we are not persuaded that we misapprehended or overlooked any matters or abused our discretion in declining to exercise discretion to deny institution.

### III. CONCLUSION

After considering Patent Owner’s arguments on rehearing, we are not persuaded that we misapprehended or overlooked any matters or abused our discretion in instituting trial in this *inter partes* review.

### IV. ORDER

In view of the foregoing, it is  
ORDERED that Patent Owner’s Request for Rehearing of the Board’s Institution Decision is *denied*.

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